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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,980	07/30/1999	DEANE E. GALLOWAY	24180-044002	7511

7590 01/10/2007
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EXAMINER	
TARAZANO, DONALD LAWRENCE	
ART UNIT	PAPER NUMBER
1773	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/369,980	Applicant(s) GALLOWAY ET AL.	
	Examiner D. Lawrence Tarazano	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

In order to set forth new grounds of rejection, this application has been returned to non-final status.

MPEP 2308.03 Interference Proceedings, Estoppel Within the Office

1. If a party loses on an issue, it may not re-litigate the issue before the examiner or in a subsequent Board of Patent Appeals and Interferences (Board) proceeding. The time for the party to make all pertinent arguments is during the interference, unless the Board expressly prevented the party from litigating the issue during the interference.

2. There are two main types of interference estoppel. First, a losing party is barred on the merits from seeking a claim that would have been anticipated or rendered obvious by the subject matter of the lost count. *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992); *Ex parte Tytgat*, 225 USPQ 907 (Bd. Pat. App. & Inter. 1985). Second, a losing party is procedurally barred from seeking from the examiner relief that could have been--but was not--sought in the interference. 37 CFR 41.127(a)(1); *Ex parte Kimura*, 55 USPQ2d 1537 (Bd. Pat. App. & Inter. 2000) (reissue applicant estopped to claim compound when patentability of that compound could have been put in issue in interference where opponent's application also described compound).

3. Claims 17, 18, 20 and 21 are rejected as being unpatentable under the principles of *res judicata* and *collateral estoppel* (*In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992)).

4. Prosecution in the instant application was suspended pending the outcome of Interference No. 105,092. The interference was decided September 16, 2005. The instant application and US Pat. No. 6,437,064, the losing party of the interference proceeding, are commonly owned. In the decision, claims 1-3, 6-19, and 22-39 of US Patent No. 6,437,064 were held unpatentable (last page of document).

5. A double patenting rejection was made and a terminal disclaimer was filed between the instant application and patent number 6,437,064; this clearly establishes the relationship between the claims of the patent and instant application.

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6. Claims 17 and 18 of the instant application is directed to the same invention as claims 36 and 39 of 6,437,064. The claims lost in the interference include five-layer structures comprising a barrier layer and surface layers containing single site catalyzed polyolefin in which layer five comprised EVA, in which the barrier layer can be EVOH. The instant claims cover multilayer structures having a barrier layer (EVOH), intermediate layers, a surface layer comprising single site catalyzed polyolefin, and a surface layer comprising EVA.

7. Claims 20, and 21 of the instant application are obvious variants of lost count as it would have been obvious to vary the thickness of the film layers depending on the end use of the film and to make it into a package.

8. The examiner also notes that the subject matter of claims 17, 18, 20 and 21 correspond in concept to claims 11, 18 and 22 of patent number (5,604,043) which is owned by Cryovac, the senior party in the decision of the interference. It would have been obvious to vary the thickness of the film layers depending on the end use of the film and to make it into a package.

9. For the reasons set forth above, the applicants are not entitled to claims 17, 18, 20 and 21 of the instant application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17, 18, 20 and 21 rejected are under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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3. The numbering of the layers is confusing. It is unclear what structure is intended.

There appear to be two layer "two".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

D. Lawrence Tarazano
Primary Examiner
Art Unit 1773

A handwritten signature in black ink, appearing to be 'DLT' or similar, enclosed within a curved line.